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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,533	07/25/2003	Donald Lynn Bissett	9332	2912

27752 7590 03/09/2007
THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
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EXAMINER

ROBERTS, LEZAH

ART UNIT	PAPER NUMBER
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1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/627,533	Applicant(s) BISSETT ET AL.	
	Examiner Lezah W. Roberts	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 11-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>A-B</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Election of Species and Restriction Requirement

Claims 11-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 16, 2007.

Applicant's election with traverse of invention I, claim 1-10 and election of species N-acyl-phenylalanine, vitamin B3 and condition agents in the reply filed on February 16, 2007 is acknowledged. The traversal is on the ground(s) that there is no undue burden placed on the Office in examining all original claims. An election in each of the requested categories would require Applicants to file as many as 30 individual application, which would place an unfair burden on Applicants. Applicants also point out that the above are not patentably distinct species but are distinct elements of a single patentable claim. Amino acids are a well-defined class and are limited in number. Applicants claims are specifically directed toward the N-acyl subclass of amino acids, which makes searching the prior art even less onerous. This is not found persuasive because the combination of the different species leads various compositions, which in turn leads to various searches. Although Applicant has directed the claims to one specific subclass, this subclass encompasses various compounds, and along with the multiple compounds encompassed by the other category of species would lead to a multitude of compositions therefore leading to a multiple of searches.

The requirement is still deemed proper and is therefore made FINAL.

Claims

Claim Rejections - 35 USC § 102 - Anticipation

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Stoltz et al. (US 2005/0118119).

Stoltz et al. discloses cosmetic compositions to lighten skin. The compositions used are generally in the form of dilute aqueous or aqueous-alcoholic solutions, in the form of simple or multiple emulsions, such as water-in-oil (W/O), oil-in-water (O/W) or water-in-oil-in-water (W/O/W) emulsions (paragraph 0054), encompassing claims 9-10. N-undecylenoyl-phenylalanine is incorporated into the compositions at a concentration ranging from 0.01 to 10% of the weight of the emulsions. As examples of active principles that may be added to the compositions include peptides, vitamins and retinol (paragraph 0067). Example 2 discloses magnesium ascorbyl phosphate in the compositions at a concentration of 2.00%, encompassing claim 8. The compositions

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also comprise water, which is a carrier. Sunscreens may also be added to the compositions. The reference anticipates the claims insofar as it discloses a skin care composition with an N-acyl amino acid, a skin care active and a dermatologically acceptable carrier.

Claim Rejections - 35 USC § 103 - Obviousness

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1) Claims 1, 5-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chevalier et al. (US 2002/0192169).

Chevalier et al. discloses cosmetic compositions for the treatment of greasy skin. The compositions may be oil-in-water emulsions. In the case of oil in water emulsions, useful emulsifiers include N-acyl-amino acids. The active ingredients include antibacterials such as zinc salts, vitamins B3 (niacinamide) as well as salicylic acid, anti-acne hexamidine and mixtures thereof (paragraph 0075). The compositions may also include chemical and physical sun filters including salicylic acid derivatives. These may be incorporated at concentrations ranging 0.01 to 20% (paragraph 0032), encompassing claims 8. The reference differs from the instant claims insofar as it does not disclose a specific example of a composition comprising vitamin B3 and the N-acyl-amino acid emulsifier.

The reference is not anticipatory insofar as one must "pick and choose" from different lists of emulsifiers and active agents. That being said, it would have been obvious in a self-evident manner to have selected an N-acyl-amino acid from one list and vitamin B3 from another, motivated by the unambiguous disclosure of each individually, and consistent with the basic principle of patent prosecution that a reference should be considered as expansively as is reasonable in determining the full scope of the contents within its four corners.

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2) Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoltz et al. (US 2005/0118119) in view of Chevalier et al. (US 2002/0192169).

The primary reference is discussed above in the anticipation section. The reference differs from the instant claims insofar as it does not disclose using vitamin B3 as one of the vitamins that may be incorporated into the compositions.

The secondary reference is discussed above in subsection 1. The reference differs from the instant claims insofar as it does not disclose N-undecenoyl-phenylalanine as the one of the N-acyl-amino acid emulsifiers.

It is *prima facie* obviousness to select a known material based on its suitability for its intended use. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Also, established precedent holds that it is generally obvious to add known ingredients to known compositions with the expectation of obtaining their known function. See, e.g., *In re Linder*, 457 F.2d 506, 507 (CCPA 1972); see also *In re Dial*, 326 F.2d 430, 432 (CCPA 1964). It would have been obvious to one of ordinary skill of the art to have incorporated vitamin B3 into the compositions of the primary reference motivated by the desire to add a vitamin that could act as an antibacterial agent for the cosmetic compositions, as supported by cited precedent and the secondary reference.

Claims 1-10 are rejected.

No claims allowed.

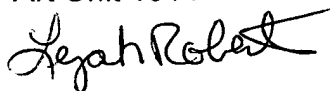
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lezah Roberts
Patent Examiner
Art Unit 1614



Frederick Krass
Primary Examiner
Art Unit 1614

